

ESTTA Tracking number: **ESTTA633097**

Filing date: **10/15/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	Lucasfilm Ltd., LLC
Granted to Date of previous extension	10/15/2014
Address	One Letterman Drive Bldg. B. San Francisco, CA 94129 UNITED STATES

Name	Lucasfilm Entertainment Company Ltd. LLC		
Entity	Corporation	Citizenship	California
Address	One Letterman Drive, Bldg. B San Francisco, CA 94129 UNITED STATES		

Attorney information	LINDA K MCLEOD KELLY IP LLP 1330 CONNECTICUT AVENUE NW, SUITE 300 Washington, DC 20036 UNITED STATES linda.mcleod@kelly-ip.com, docketing@kelly-ip.com, jacob.mersing@kelly-ip.com
----------------------	---

Applicant Information

Application No	86182204	Publication date	06/17/2014
Opposition Filing Date	10/15/2014	Opposition Period Ends	10/15/2014
Applicant	Walton Street Brewing Corp. 120 Walton Street Syracuse, NY 13202 UNITED STATES		

Goods/Services Affected by Opposition

Class 032. First Use: 2004/06/01 First Use In Commerce: 2004/06/01
All goods and services in the class are opposed, namely: Ale; Beer

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	EMPIRE STRIKES BACK		
Goods/Services	toys, games, apparel, video/computer games, personal-care products, paints, trading cards, confections, prerecorded films and music, books, magazines, music, and entertainment services		

Attachments	Notice of Opposition - 2014.10.15.pdf(574841 bytes)
-------------	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Linda K. McLeod/
Name	LINDA K MCLEOD
Date	10/15/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>LUCASFILM LTD. LLC and LUCASFILM ENTERTAINMENT LTD., LLC,</p> <p>Opposer,</p> <p>v.</p> <p>WALTON STREET BREWING CORP.,</p> <p>Applicant.</p>	<p>Opposition No.:</p> <p>Mark: EMPIRE STRIKES BOCK</p> <p>Serial No.: 86182204</p> <p>Filed: February 3, 2014</p>
--	--

NOTICE OF OPPOSITION

Lucasfilm Ltd. LLC, a limited liability company, is organized in the State of California, and has a principal place of business at One Letterman Drive, Bldg. B, San Francisco, California 94129. Lucasfilm Entertainment Company Ltd. LLC, a limited liability company and wholly-owned subsidiary of Lucasfilm Ltd. LLC, has a principal place of business at One Letterman Drive, Bldg. B , San Francisco, CA 94129 (collectively, “Opposer” or “Lucasfilm”). Lucasfilm believes that it is being and will be damaged by the registration of the mark shown in Application Serial No. 86182204, and hereby opposes the same. As grounds for opposition, Lucasfilm alleges that, upon actual knowledge with respect to itself and its own acts, and upon information and belief as to other matters:

**Lucasfilm’s Common Law Rights
in its THE EMPIRE STRIKES BACK Mark**

1. Founded in 1971, Lucasfilm, through its predecessors-in-interest, related companies and licensees, is one of the world’s leading producers and providers of entertainment, films, and various consumer products.

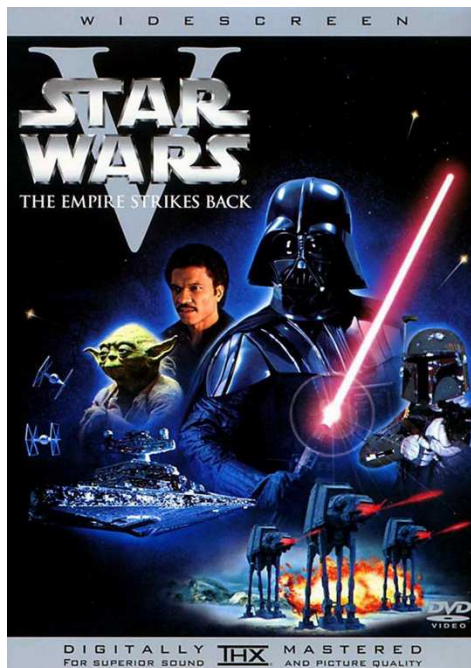
2. In 1977, Lucasfilm released the first in a series of enormously successful films within its STAR WARS film franchise entitled "STAR WARS." The STAR WARS film series was created by George Lucas, and featured the actors Mark Hamill as Luke Skywalker, Harrison Ford as Han Solo, Carrie Fischer as Princess Leia, and Alec Guinness as Obi-Wan Kenobi, among others. The first film in the series introduces a space galaxy in civil war where Luke Skywalker joins forces with Jedi Master Obi-Wan Kenobi, Han Solo, a "Wookiee" named Chewbacca, and two Droids, R2D2 and C3PO, to save the universe from the Galactic Empire's battle-station Death Star, and to rescue Princess Leia from the evil character Darth Vader. The STAR WARS film earned hundreds of millions of dollars in domestic box office revenues, and an Academy Award nomination for Best Picture. The original STAR WARS film was followed by two sequels, and a trilogy of prequels, which have been enormously successful and popular among consumers. Further, Lucasfilm has announced plans to release several new films as part of the STAR WARS film franchise (collectively, the "STAR WARS Film Franchise").

3. In 1980, Lucasfilm released its blockbuster STAR WARS sequel entitled "THE EMPIRE STRIKES BACK." This film has been named among the greatest films of all time. THE EMPIRE STRIKES BACK film earned approximately \$290 million in domestic box office revenue and over \$240 million in international box office revenue. It was nominated for three Academy Awards, and won the Academy Award for best sound. The original release of the THE EMPIRE STRIKES BACK film was in over 1250 movie theatres, exposing many millions of consumers to THE EMPIRE STRIKES BACK film and mark.

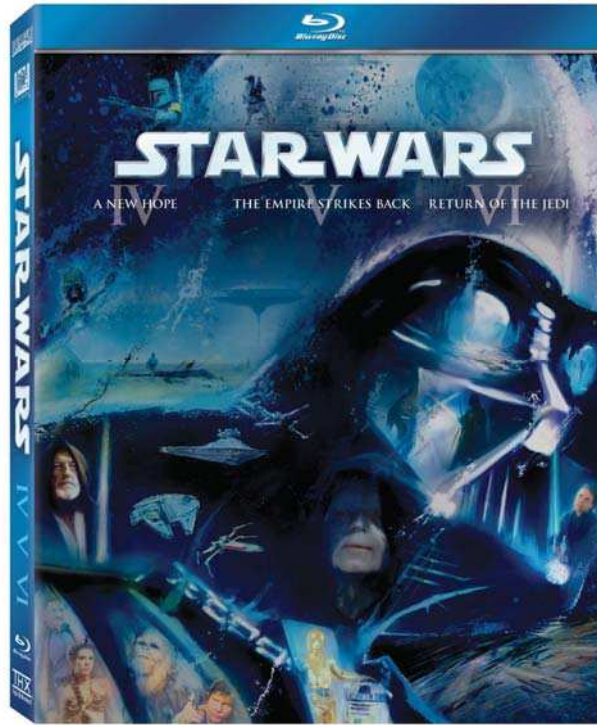
4. Since its theatrical release in 1980, Lucasfilm's THE EMPIRE STRIKES BACK mark has been used in connection with prerecorded films, which have been re-released in different formats and bundled products over the years. Lucasfilm's THE EMPIRE STRIKES BACK prerecorded films have been offered and sold by major retail stores and outlets, including but not limited to Target, Best Buy, Amazon.com, BJ's, Fry's Electronics, Sam's, Transworld, Shopko, Kmart, and Walmart.

5. For example, in 2004, THE EMPIRE STRIKES BACK film was released on DVD and bundled in a box set with A NEW HOPE, RETURN OF THE JEDI, and a bonus disc of extra features.

6. THE EMPIRE STRIKES BACK film was also re-released in 2006 on a separate two-disc Limited Edition DVD, as shown below, and then later re-released in a trilogy box set in 2008.



7. In 2011, THE EMPIRE STRIKES BACK FILM was released on Blu-ray disc, as shown below.



8. In addition to its films, Lucasfilm published a novel in 1980 entitled “STAR WARS: THE EMPIRE STRIKES BACK,” which is based on the original film.

9. Following the release of THE EMPIRE STRIKES BACK film in 1980, Lucasfilm engaged in extensive licensing and merchandising under the mark. For example, Lucasfilm has used its THE EMPIRE STRIKES BACK mark in connection with a wide range of toys, games, apparel, video/computer games, personal-care products, paints, trading cards, confections, prerecorded films and music, books, magazines, and music, among other things. Representative images of Lucasfilm's THE EMPIRE STRIKES BACK merchandise are shown below (collectively, “Lucasfilm’s Goods and Services”):





10. In addition to Lucasfilm's THE EMPIRE STRIKES BACK films, novel, and merchandise, THE EMPIRE STRIKES BACK mark is prominently featured on Lucasfilm's website at <http://www.starwars.com/>, where consumers can watch video clips, view images, play games, and read articles referring and relating to THE EMPIRE STRIKES BACK, among other things.

11. Further, over the years, Lucasfilm's THE EMPIRE STRIKES BACK mark has received extensive media attention in national publications, exposing millions of consumers to the mark. For example, Lucasfilm's THE EMPIRE STRIKES BACK mark has been featured in *USA Today*, *The Washington Post*, *The New York Times*, *Chicago Tribune*, *The Boston Globe*, *Los Angeles Times*, *The Baltimore Sun*, *Tampa Bay Times*, *The Seattle Times*, and *The Denver Post*, just to name a few.

12. Through its long use of the distinctive THE EMPIRE STRIKES BACK mark, substantial advertising and promotion under that mark, and extensive media attention under that mark, Lucasfilm has developed substantial goodwill in THE EMPIRE STRIKES BACK mark, and the mark has long been famous.

**Lucasfilm's Long History of Using and/or Licensing Marks From
its STAR WARS Film Franchise in Connection with Wine**

13. As part of its extensive licensing and merchandising programs, Lucasfilm has a long history of using and/or licensing marks from its STAR WARS Film Franchise in connection with food and beverages, including wine.

14. For over twenty years, Lucasfilm and/or its licensees have used the SKYWALKER mark in connection with wines produced from SKYWALKER VINEYARDS. As early as 1991, Lucasfilm and/or its licensees first planted vines on

SKYWALKER RANCH near the technical buildings that hold the post-production sound company known as SKYWALKER SOUND. SKYWALKER VINEYARDS has produced award-winning wines prominently bearing the SKYWALKER mark, as shown in the images below. Thus, for decades, consumers have been exposed to and understand that Lucasfilm's STAR WARS Film Franchise marks are used in connection with such products.



Applicant and Its EMPIRE STRIKES BOCK Mark

15. Walton Street Brewing Corp. (“Applicant”), the listed owner of Application Serial No. 86182204, is a New York corporation with an address of 120 Walton Street, Syracuse, New York 13202.

16. On February 3, 2014, Applicant filed Application Serial No. 86182204 to register the EMPIRE STRIKES BOCK mark (“Application”) under Section 1(a), 15 U.S.C. §1051(a), before the U.S. Patent and Trademark Office (“PTO”) for “ale; beer” in Class 32 (“Applicant’s Goods”), with an alleged date of first use and date of first use in commerce of June 1, 2004.

17. On June 17, 2014, Applicant's mark was published for Opposition in the Trademark Official Gazette (TMOG), and on July 15, 2014, Opposer Lucasfilm Ltd. LLC filed a timely extension of time to oppose.

Count I:
Likelihood of Confusion, 15 U.S.C. § 1052(d)

18. Lucasfilm repeats and realleges each and every allegation set forth above.

19. Lucasfilm has priority based on prior use of its THE EMPIRE STRIKES BACK mark in commerce on or in connection with Lucasfilm's Goods and Services before the filing date of the Application, and before any date of first use that Applicant has alleged or may allege.

20. Applicant's EMPIRE STRIKES BOCK mark is virtually identical in sound, appearance, and connotation to Lucasfilm's THE EMPIRE STRIKES BACK mark, differing by only one letter in the respective last words "BOCK" and "BACK," and the initial word "THE."

21. Applicant's Goods are related to Lucasfilm's Goods and Services advertised, promoted, offered, and/or sold by Lucasfilm in connection with its THE EMPIRE STRIKES BACK mark. As noted above, Lucasfilm has a history of using marks from its STAR WARS Film Franchise in connection with a wide variety of products. In particular, Lucasfilm has a long history of using such marks for food and beverages, including wine. The fact that consumers have been exposed to and accustomed to seeing Lucasfilm's STAR WARS Film Franchise marks in connection with food and beverages, including wine, increases the already existing likelihood of confusion.

22. Accordingly, Applicant's EMPIRE STRIKES BOCK mark shown in Application Serial No. 86182204 so resembles Lucasfilm's previously used THE EMPIRE STRIKES BACK mark as to be likely, when used in connection with Applicant's Goods, to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Lanham Act, as amended, 15 U.S.C. § 1052(d).

Count II:
Dilution, 15 U.S.C. § 1125 (c)(1)

23. Lucasfilm repeats and realleges each and every allegation set forth in the above paragraphs.

24. Lucasfilm has engaged in extensive, nationwide advertising, promotion, and use of its THE EMPIRE STRIKES BACK mark. Further, Lucasfilm has had massive sales of Lucasfilm's Goods and Services in connection with THE EMPIRE STRIKES BACK mark nationwide for decades.

25. Lucasfilm's THE EMPIRE STRIKES BACK mark has for many years received extensive media attention nationwide. Such extensive and frequent media attention has had a substantial impact on the public, and has long created an association in the minds of consumers between Lucasfilm's THE EMPIRE STRIKES BACK mark and Lucasfilm.

26. Lucasfilm's THE EMPIRE STRIKES BACK mark is a strong and inherently distinctive mark that became famous, as defined under Section 43(c)(1) of the Lanham Act, as amended, 15 U.S.C. § 1125(c)(1), well before the filing date of Application Serial No. 86182204, and any date of first use that Applicant has alleged or may allege.

27. In view of the substantial similarities between the Applicant's EMPIRE STRIKES BOCK mark and Lucasfilm's THE EMPIRE STRIKES BACK mark noted

above, Applicant's mark so closely resembles Lucasfilm's famous THE EMPIRE STRIKES BACK mark as to be likely to dilute the distinctive quality of such mark in violation of Section 43(c)(1) of the Lanham Act, as amended, 15 U.S.C. § 1125(c)(1).

WHEREFORE, Lucasfilm believes that it is being damaged, and will be damaged, by the registration of the mark shown in Application Serial No. 86182204 and respectfully requests that the opposition be sustained, and that registration to Applicant be refused.

The filing fee has been submitted electronically. Any deficiency in the fee should be charged to Deposit Account No. 506154.

Respectfully submitted,

Dated: October 15, 2014

By: /Linda K. McLeod/

David M. Kelly
david.kelly@kelly-ip.com
Linda K. McLeod
linda.mcleod@kelly-ip.com
Radiance W. Harris
radiance.harris@kelly-ip.com
Kelly IP, LLP
1330 Connecticut Ave., N.W.
Suite 300
Washington, D.C. 20036
Telephone: 202-808-3570
Facsimile: 202-354-5232
Attorneys for Lucasfilm

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing NOTICE OF OPPOSITION was served by first class mail, postage prepaid, on October 15, 2014, upon Applicant's attorney of record at the following correspondence address of record:

Bernhard P. Molldrem Jr.
Law Office of Bernhard Molldrem
224 Harrison Street, Suite 200
Syracuse, New York 13202-3052

/Jacob T. Mersing/
Jacob T. Mersing
Senior Legal Assistant